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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,235	01/12/2001	Stefano Turri	108910-00022	7869

7590

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/758,235

Applicant(s)  
Turri et al.

Examiner  
Rabon Sergeant

Art Unit  
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 5 6) ☐ Other:

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1. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear what compounds are encompassed by the language, “non cyclic isocyanic trimer”. It is unclear from applicants’ claims if the language is limited to biurets. Furthermore, within the art, biurets are not normally considered to be trimers.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 2 of claim 1, the language, “based on”, renders the claims indefinite, because it is unclear to what extent the compositions are based on or derived from polyisocyanate and (per)fluoropolyethers.

Within the claims, the meaning of the terms, “dry product” and “dry content”, is not clear.

Within line 3 of claim 1, the (per)fluoropolyether should not be referred to in the form of an abbreviation.

Throughout the claims, all language denoted by the terms, “preferably”, “for example”, and “such as”, renders the claims indefinite; the use of the language is akin to claiming a range within a range.

Within line 11 of claim 1, the language, “the cyclic trimer”, lacks antecedent basis.

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Within lines 18 and 19, the language, “the ratio referred to the dry product ...”, is not understood.

Within lines 27 and 28 of claim 1, the language, “under crosslinking conditions”, renders the claims indefinite, because, firstly, it is unclear what is under crosslinking conditions, and, secondly, it is unclear what constitutes crosslinking conditions.

Within line 28 of claim 1, it is unclear what is meant by “complement to 100%”.

Within claims 2 and 14, the use of the word, “obtainable”, renders the claims indefinite, because one cannot determine what products can be obtained by the claimed process and what products cannot be obtained by the claimed process. The language fails to convey an absolute or definitive limitation.

Within line 4 of claim 2, the language, “solvent as those indicated in component 3)”, renders the claim indefinite, because it is unclear if the language encompasses solvents other than those set forth within claim 1.

Within claim 2, it is unclear what constitutes “the indicated limits”.

Within claims 1 and 2, applicants have failed to set forth bases for the claimed dry content weight percents.

Within line 4 of claim 6, it is unclear how the first and last units differ when  $a'$  equals 3.

Within line 6 of claim 6, the species, H and Cl, should be referred to in the alternative.

The subject matter of claim 7 is confusing. For the definition of  $aI$ ), applicants initially indicate that  $n'$  is not zero; however, applicants then indicate that  $n'$  can be zero. Furthermore, it

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is unclear what is meant by the language, “the above indicated limits” and “such as to be comprised in the above mentioned limits”. Within line 22 of claim 7, the species, H and Cl, should be referred to in the alternative. With respect to bI) it is unclear how t' can be zero and still satisfy the t'/p' ratio value range. Lastly, when n' equals zero within aI) and when a' equals 3 within dI), it is unclear how aI) and dI) differ.

Within claims 7 and 9, the use of “can” renders the claims indefinite, because it is unclear to what extent the language denoted by “can” is an optional or required limitation.

Within lines 1 and 2 of claim 8, the language, “the two end groups”, lacks antecedent basis.

Within line 3 of claim 8, the use of “type” renders the claims indefinite, because it is unclear if “type” encompasses end groups not governed by the structure. Also, the language, “the preferred compounds”, renders the claims indefinite, because it is unclear if or to what extent the preferred language is to limit the less preferred language.

The language within lines 4 and 5 of claim 11 cannot be understood. There appears to be an omission within the language.

Within claim 13, the Markush language and structure of the Markush group are improper. Firstly, the initial language should be the accepted Markush language, “selected from the group consisting of”. Secondly, the species of the group are improper, because genus/species relationships should not be exemplified. It cannot be determined how the species are to limit the genus.

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Within line 10 of claim 13, it is unclear how “generally” is to affect the limitation. What “general” conditions must be satisfied, and how are they distinguished from non-general conditions?

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent

September 27, 2002